

Amendment and Response

Applicant: William J. Bertrand et al.

Serial No.: 10/698,117

Filed: October 31, 2003

Docket No.: M190,247,101 / P0011522.00

Title: INDICATOR TOOL FOR USE WITH AN IMPLANTABLE MEDICAL DEVICE

REMARKS

The following remarks are made in response to the Non-Final Office Action mailed December 23, 2009. With this Response, claims 8 and 13 have been amended. After entry of this Response, claims 1-36 remain pending in the application and are presented for reconsideration and allowance.

Drawing Objections

In the Office Action, the drawings were objected to under 37 C.F.R. 1.84(p)(5). Figs. 1 and 2 and the Specification have been amended to address each of the issues identified by the Examiner. Support for the two added paragraphs is found in Paragraphs [0009] and [0010] of Bertrand, U.S. Patent Publication No. 2002/0022793, which was incorporated into this patent application by reference in Paragraph [0007] of the present application.

35 U.S.C. §112, Second Paragraph, Rejections

Claims 13-17 were rejected under 35 U.S.C. §112, second paragraph. The amendment of claim 13 is believed to obviate this rejection. Reconsideration and withdrawal of this rejection are respectfully requested.

35 U.S.C. §103 Rejections

Claims 8, 10-13, and 15-17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Bertrand et al., U.S. Publication No. 2002/0022793 ("Bertrand") in view of Weijand et al., U.S. Patent No. 6,305,381 ("Weijand").

In support of this rejection, the Examiner referenced Bertrand for disclosing each of the elements in claim 8 except an electronic processor. The Examiner then cited Weijand for disclosing this aspect and contended that it would have been obvious to combine Bertrand and Weijand to produce the claimed invention.

As an initial point in responding to this rejection, it is noted that independent claims 8 and 13 have been amended to more clearly define the unique aspects of the invention. These

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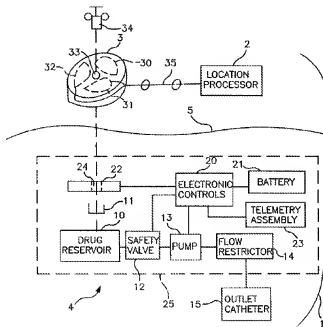
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claims now indicate that background magnetic field data is received from the background compass module and the target magnetic field data is received from the target compass module.

Bertrand discloses a manual system for determining the position of a valve using orientation of magnetic field.

Weijand discloses a drug delivery device having a refillable reservoir 10, as illustrated in Fig. 1 that is set forth below. The drug delivery device 4 includes an implant coil 22 that is used for locating a septum 11 that is used for refilling the reservoir 10. An implant location antenna array 3 is positioned above the patient's skin 5.

**FIG. 1**

While Weijand and the claimed invention both use magnets in a device that is implanted beneath a person's skin to determine a location of the implanted device, the operation of the respective devices is quite different.

Weijand uses the magnetic field to ensure that a guide is positioned above a drug reservoir. On the other hand, the claimed invention uses the magnetic field to determine a setting of a valve in an implanted medical device. Thus, the claimed invention needs to not only

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determine the location of the valve so that the sensor can be positioned above the valve but also the orientation of the valve.

Similarly, there are significant differences between Weijand and Bertrand because Bertrand like the claimed invention is directed to determining a setting of a valve on an implanted medical device.

Based upon the preceding comments, it is submitted that it would not have been obvious to combine Bertrand and Weijand as contended by the Examiner. Even if Bertrand was combined with Weijand, it would not produce a system that receives target magnetic field data and background magnetic field data and then uses these two types of data to determine the position of the valve.

Therefore, independent claims 8 and 13 are not obvious when viewed in light of Bertrand and Weijand. Claims 10-12 and 15-17 depend from independent claim 8 or 13. As such, these claims are also non-obvious when viewed in light of the cited references. Reconsideration and withdrawal of this rejection are respectfully requested.

Claims 9 and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Bertrand in view of Weijand as applied to claims 8 or 13 above, and further in view of Abraham-Fuchs, U.S. Patent No. 5,136,242 ("Abraham-Fuchs").

The Examiner contended that Bertrand and Weijand disclose each of the elements except subtracting the background data from the target data. The Examiner cited Abraham-Fuchs for disclosing this aspect and contended that it would have been obvious to combine the three references to produce the claimed invention.

Abraham-Fuchs issued on August 4, 1992, which is nearly 6 years before the filing date of Bertrand and Weijand. Even though Abraham-Fuchs was publicly available a significant amount of time before Bertrand and Weijand, it would have been expected that the concepts would have been discussed in Bertrand or Weijand if these concepts would have truly been obvious to a person of ordinary skill in the art. However, that is not the case.

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Because, as acknowledged by the Examiner, Bertrand does not disclose an electronic processor, there would have been no reason for Bertrand to include the concepts relating to comparing background data and target data in Bertrand.

Additionally, since Weijand is merely directed to accurately positioning the location antenna array with respect to the implant coil as opposed to also determining an orientation of the implant coil, it was not necessary for Weijand to be concerned about tracking both the target magnetic field data and the background magnetic field data. Tracking this information becomes important when accurately positioning the antenna array and determining an orientation of the implant coil. In view of these differences, it is submitted that there was no motivation to combine Abraham-Fuchs with Bertrand and Weijand as is contended by the Examiner.

Additionally, Claims 9 and 14 depend from independent claims 8 and 13, respectively. Based upon the comments set forth above, it is submitted that there are significant differences between independent claims 8 and 13 and Bertrand and Weijand. Abraham-Fuchs does not overcome these deficiencies. Accordingly, claims 9 and 14 are non-obvious when viewed in light of the references cited by the Examiner. Reconsideration and withdrawal of this rejection are respectfully requested.

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CONCLUSION

In view of the above, Applicant respectfully submits that the pending claims are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of these claims is respectfully requested.

No fees are required under 37 C.F.R. 1.16(h)(i). However, if such fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 50-0471.

Any inquiry regarding this Response should be directed to Michael Bondi at Telephone No. (612) 573-2000, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

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